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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 20031203

Application Number: 10/034,110
Filing Date: December 26, 2001
Appellant(s): DAVIS ET AL.

John M. Dahl
For Appellant

Supplemental
EXAMINER'S ANSWER

MAILED

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GROUP 2800

This is in response to the appeal brief filed Nov. 10, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1, 3-6, 32-34 and 36-51 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,185,097 B1	Behl	2-2001
6,175,490 B1	Papa et al.	1-2001

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3-6, 32-34, 36-41 and 44-51 are rejected under 35 U.S.C. 102(e) as being anticipated by Behl (US 6,185,097 B1).

Behl teaches a cooling assembly comprising:

- A passage (passage of one fan of 30s, fig. 2, each fan having its own passage) (claims 1 and 34)
- A first fan (one of fans 30, fig. 2) (claims 1 and 34)
- An isolation assembly (200, fig. 12) for generally enclosing heat generated from a first component (14, figs. 12), being removably attachable to a computer case (10, fig. 1) without opening the computer case, and being separate from another heat-sensitive component (another 14, fig. 1) (claims 1 and 34)

- An alternate passage (passage of another fan 30, fig. 2) configured to provide an air flow path to the isolation assembly (claims 1, 3, 34 and 36)
- A second fan (another fan 30, fig. 12) suitable for passing air through the alternate passage (claims 1 and 34)
- A passive heat sink (18, fig. 1) operatively coupled to the first component (claims 4, 32, 37 and 40)
- Wherein a plurality of components (fig. 9) are enclosed in a case, and air is drawn from outside (22, fig. 1) (claims 5-6 and 38-39)
- Wherein the isolation assembly is configured to shield the first component from an amount of EMI (EMI shield 28 is part of the assembly; also see col. 3, lines 6-13) (claims 33 and 41)
- An exhaust hole (on a rear wall of 10, not numbered, fig. 1) in communication with the passage and suitable for venting air through the computer case (claims 44 and 48)
- An air path (shown in fig. 1, not numbered) from the first fan through the exhaust hole passes through the passage (claims 45 and 49)
- Wherein the cooling assembly is configured such that substantially all of the air passing through the first fan is vented through the exhaust hole (shown in fig. 1) (claims 46-47 and 50-51)

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 42 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Behl in view of Papa et al. (US 6,175,490 B1).

Behl discloses the claimed invention except the first component comprising a processor.

Papa teaches a processor (200, fig. 2) enclosed in an isolation assembly (103, fig. 3A; see also col. 4, lines 16-22).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the isolation assembly of Behl with the isolation assembly taught by Papa et al. such that the heat generated by the processor could be effectively handled by the cooling assembly, since processors are heat-generating sources.

(11) Response to Argument

1) Regarding the rejection of claims under 35 USC 102(e)

Appellant argues, in reference Behl, “no mention is made of a circuit board accepting a plurality of components, including a first component, as is recited in independent claims 1 and 34 of the present invention”.

In the independent claims 1 and 34 of this application, the preamble states: “A cooling assembly for at least one board, the at least one board suitable for accepting a plurality of components including a first component”. The “for at least one board” is a statement of intended use or purpose of the invention; it does not limit the scope of the claims since such statements merely define the context in which the invention operates.

See MPEP §2111.02. Further more, a board, even a circuit board, is an inherent part of a disk drive; "suitable for accepting a plurality of components" may not mean the plurality of components being on the board.

Furthermore, regarding claim 3, a conduit, separated from the first and second fans, in communication with the isolation assembly is shown as 12 in fig. 1; regarding claim 4, "a heat sink operably coupled to the first component" is shown as 18, in fig. 1, and "the component in claim 1 is accepted on a board" is not claimed (see reasons given in paragraph hereinabove); regarding claim 5, "wherein the plurality of components are enclosed within a case" is clearly shown in fig. 1, and the statement "Claim 5 references multiple components on the board in the isolation assembly" is incorrect, since this is not claimed; and regarding claim 6, "a plurality of components" is shown in fig. 1 as stated above, and "the air is drawn from within the case" is also shown in fig. 1 as indicated by the arrows that air is drawn into isolated assembly 12 from within the case of 10.

2) Regarding the rejection of claims under 35 USC 103(a)

Applicant argues, "proper motivation to combine the references has not been given."

The motivation stated in the 103(a) rejection states: "... such that the heat generated by the processor could be effectively handled by the cooling assembly, since processors are heat-generating sources." The invention claimed is a cooling assembly. The application of a cooling assembly is removing heat from a heat source. Since, Papa teaches a processor which inherently gives off heat, it would have been obvious to use

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the Behl's device to cool Papa's processor to increase performance and longevity of the processor.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Yean-Hsi Chang
Examiner
Art Unit 2835

A handwritten signature in black ink, appearing to read 'Yean-Hsi Chang', followed by the date '6/8/04'.

Conferees:

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